

REMARKS

By this Amendment, claims 2, 4-6, 11, 19, 24, 27, 29, 33, 39-40, 42 and 44 are amended, and claims 1, 3, 10, 18, 20-23, 28, 32, 34-36 and 38 are canceled, without prejudice to or disclaimer of the subject matter recited therein. Accordingly, claims 2, 4-9, 11-19, 24-27, 29-31, 33, 37 and 39-44 are pending in this application. No new matter is added.

The courtesies extended to Applicant's representative by Examiners Barbee and Hoff at the interview held August 27, 2003, are appreciated. The reasons presented at the interview as warranting favorable action are incorporated into the remarks below and constitute Applicants' record of the interview.

Claims 1-5, 18, 19, 23, 25, 27, 28, 32-34, 37, 38 and 44 stand rejected under 35 U.S.C. §102(b) over U.S. Patent No. 5,057,866 to Hill, Jr. et al. This rejection is moot with respect to canceled claims 1, 3, 18, 23, 28, 32, 34 and 38, and is respectfully traversed with respect to the remaining claims.

Claim 4 is amended to be in independent form and to further clarify the meaning of "a revised set of operating instructions" as recited in original claim 4. Specifically, as discussed at the personal interview and as described in the original specification, the revised set of operating instructions refers to instructions that affect the actual operation of the electronic system, not the diagnosis of the electronic system. For the sake of clarity, claim 4 is amended to recite that the revised set of operating instructions correct a failure or prevent a failure of the at least one electronic system. Since the applied references do not disclose, teach or suggest revised operating instructions and this amendment only clarifies the inherent meaning of "revised set of operating instructions" originally recited in claim 4, it is respectfully submitted that the scope of claim 4 is not narrowed by this amendment.

As clarified by the Examiners at the personal interview, the disclosure in Hill, Jr. et al. of sending new thresholds to the copier (col. 6, lns. 9-48) is asserted in the Office Action as

allegedly corresponding to the recitation of a communication sent by a remote diagnostic system including a revised set of operating instructions. Applicants respectfully disagree.

As discussed at the personal interview, the new thresholds sent to the copier according to Hill, Jr. et al. are not operating instructions because the thresholds do not affect the operation of the copier. On the contrary, the thresholds only affect the self-diagnosis of the copier by changing the parameters that will cause the copier to identify a fault. As set forth in the Summary of the Invention of Hill, Jr. et al., the purpose of the new thresholds is for "remotely altering the predetermined status conditions by which to monitor the machine." (Col. 2, lns. 21-35.) Thus, the thresholds according to Hill, Jr. et al. are not "a revised set of operating instructions" as recited in independent claim 4.

Therefore, it is respectfully submitted that independent claim 4 is patentable over Hill, Jr. et al. at least for the foregoing reasons.

Claim 19 is amended to be in independent form and to further clarify the meaning of "a revised set of operating instructions" as discussed above with respect to claim 4. Further, claim 19 is amended to include the features recited in original claims 20-23, corresponding to the features recited in claim 4. Therefore, it is respectfully submitted that independent claim 19 is patentable over Hill, Jr. et al. at least for the reasons set forth above with respect to independent claim 4.

Claim 33 is amended to be in independent form and to further clarify the meaning of "a revised set of operating instructions" as discussed above with respect to claim 4. Further, claim 33 is amended to include the features recited in original claims 34-36 and 38, corresponding to the features recited in claim 4. Therefore, it is respectfully submitted that independent claim 33 is patentable over Hill, Jr. et al. at least for the reasons set forth above with respect to independent claim 4.

Independent claim 44 is amended to recite that the communication from the remote diagnostic system comprises at least one of repair information to a third party, a parts request to a third party and a revised set of operating instructions to the at least one electronic system, the revised set of operating instructions at least one of correcting a failure and preventing a failure of the at least one electronic system. These features correspond to the features recited in claim 4. Therefore, it is respectfully submitted that independent claim 44 is patentable over Hill, Jr. et al. at least for the reasons set forth above with respect to independent claim 4.

Further, it is respectfully submitted that claims 2, 5, 24-31, 37 and 39-41 are patentable over Hill, Jr. et al. at least in view of the patentability of claims 4, 19 and 33 from which they respectively depend, as well as for the additional features they recite. Accordingly, withdrawal of the rejection of claims 1-5, 18, 19, 23, 25, 27, 28, 32-34, 37, 38 and 44 under 35 U.S.C. §102(b) over U.S. Patent No. 5,057,866 to Hill, Jr. et al. is respectfully requested.

Claim 10 stands rejected under 35 U.S.C. §102(b) over U.S. Patent No. 4,241,406 to Kennedy et al. This rejection is moot in view of the cancellation of claim 10. Accordingly, withdrawal of the rejection is respectfully requested.

Claims 6-9, 20, 22, 29-31, 36, 40 and 41 stand rejected under 35 U.S.C. §103(a) over Hill, Jr. et al. in view of Kennedy et al. This rejection is moot with respect to canceled claims 20, 22 and 36, and is respectfully traversed with respect to the remaining claims.

It is respectfully submitted that a person of ordinary skill in the art would not have been motivated to combine Hill, Jr. et al. and Kennedy et al. as asserted in the Office Action. The Office Action asserts that it would have been obvious "to modify the copier calculator, as taught by Hill, Jr. et al., . . . because then proper operation of the ink jet head would have been assured." In support of this statement, the Office Action cites column 1, lines 17-30 of Kennedy et al.

As discussed at the personal interview, it is respectfully submitted that the stated motivation is improper and appears to be based on impermissible hindsight reasoning. Specifically, the stated motivation is logically flawed because the copier of Hill, Jr. et al. does not include an ink jet head and thus assuring the proper operation of the ink jet head could not have motivated one skilled in the art to combine the references. In other words, the rationale of the Office Action appears to be that a person skilled in the art would have been motivated to modify the copier of Hill, Jr. et al. based on the teachings of Kennedy et al. if the copier of Hill, Jr. et al. were modified to include an ink jet head. However, the Office Action does not establish any basis for modifying the copier of Hill, Jr. et al. to include an ink jet head.

Therefore, it is respectfully submitted that the alleged motivation is improper and that the Office Action fails to establish a *prima facie* case of obviousness based on the asserted combination of Hill, Jr. et al. and Kennedy et al.

Claim 6 is amended to be in independent form. In view of the foregoing, it is respectfully submitted that claim 6 is patentable over the applied references. Further, it is respectfully submitted that claims 7-9 are patentable over the applied references at least in view of the patentability of claim 6 from which they depend, as well as for the additional features they recite.

Claim 29 is amended to depend from claim 19. As discussed above, Hill, Jr. et al. fails to disclose, teach or suggest every feature recited in claim 19. It is respectfully submitted that Kennedy et al. does not overcome the deficiencies of Hill, Jr. et al. with respect to claim 19. Therefore, it is respectfully submitted that claims 29-31 are patentable over the asserted combination of Hill, Jr. et al. and Kennedy et al.

Claim 40 is amended to depend from claim 33. As discussed above, Hill, Jr. et al. fails to disclose, teach or suggest every feature recited in claim 33. It is respectfully submitted that Kennedy et al. does not overcome the deficiencies of Hill, Jr. et al. with

respect to claim 33. Therefore, it is respectfully submitted that claims 40-41 are patentable over the asserted combination of Hill, Jr. et al. and Kennedy et al.

In view of the foregoing, withdrawal of the rejection of claims 6-9, 20, 22, 29-31, 36, 40 and 41 under 35 U.S.C. §103(a) over Hill, Jr. et al. in view of Kennedy et al. is respectfully requested.

Claims 11-13, 15-17, 42 and 43 stand rejected under 35 U.S.C. §103(a) over Kennedy et al. in view of Hill, Jr. et al. This rejection is respectfully traversed.

It is respectfully submitted that a person of ordinary skill in the art would not have been motivated to combine Kennedy et al. and Hill, Jr. et al. as asserted in the Office Action. The Office Action asserts that it would have been obvious "to modify the system for analyzing a[n] ink jet, as taught by Kennedy et al., . . . because then it would not have been necessary for a technician to be on site for all repairs." In support of this statement, the Office Action cites column 1, lines 5-66 of Hill, Jr. et al.

As discussed at the personal interview, it is respectfully submitted that the stated motivation is improper and appears to be based on impermissible hindsight reasoning. Specifically, the stated motivation is flawed because the system of Kennedy et al. already does not require a technician to be on site for all repairs. As stated in Kennedy et al., for example in the Summary of the Invention (col. 1, lns. 41-49), the systems and methods according to Kennedy et al. are designed to analyze operation of the ink jet head, to determine faults and to initiate recovery procedures where possible. Thus, the unmodified system of Kennedy et al. renders it unnecessary for a technician to be on site for all repairs. Therefore, this cannot provide a motivation for one skilled in the art to combine the references. In other words, the rationale of the Office Action appears to be that a person skilled in the art would have been motivated to modify the system of Kennedy et al. based on the teachings of Hill, Jr.

et al. to increase complexity and costs to provide a benefit that is already provided by the system according to Kennedy et al.

Therefore, it is respectfully submitted that the alleged motivation is improper and that the Office Action fails to establish a *prima facie* case of obviousness based on the asserted combination of Kennedy et al. and Hill, Jr. et al.

Claim 11 is amended to be in independent form. Claim 42 is amended to correct a minor informality. In view of the foregoing, it is respectfully submitted that independent claims 11 and 42 are patentable over the applied references. Further, it is respectfully submitted that claims 12-13, 15-17 and 43 are patentable over the applied references at least in view of the patentability of claims 11 and 42 from which they respectively depend, as well as for the additional features they recite.

In view of the foregoing, withdrawal of the rejection of claims 11-13, 15-17, 42 and 43 stand rejected under 35 U.S.C. §103(a) over Kennedy et al. in view of Hill, Jr. et al. is respectfully requested.

Claim 14 stands rejected under 35 U.S.C. §103(a) over Kennedy et al. in view of Hill, Jr. et al., and further in view of U.S. Patent No. 6,584,430 to Rosenbaum. This rejection is respectfully traversed.

At least for the reasons set forth above, it is respectfully submitted that the alleged motivation for combining Kennedy et al. and Hill, Jr. et al. is improper. Thus, the Office Action fails to establish a *prima facie* case of obviousness based on the asserted combination of Kennedy et al., Hill, Jr. et al. and Rosenbaum. Accordingly, withdrawal of the rejection of claim 14 under 35 U.S.C. §103(a) over Kennedy et al. in view of Hill, Jr. et al., and further in view of Rosenbaum is respectfully requested.

Claims 24, 26 and 39 stand rejected under 35 U.S.C. §103(a) over Hill, Jr. et al. This rejection is respectfully traversed.

Claims 24 and 26 are amended to depend from claim 19. Therefore, it is respectfully submitted that claims 24 and 26 are patentable over Hill, Jr. et al., at least in view of the patentability of claim 19 from which they depend.

Claims 39 is amended to depend from claim 33. Therefore, it is respectfully submitted that claim 39 is patentable over Hill, Jr. et al., at least in view of the patentability of claim 33 from which it depends.

Further, Applicants respectfully traverse the assertion of Official Notice in the Office Action. Applicants respectfully request citation of a reference that supports the position stated in the Office Action. As discussed at the personal interview, the general assertion in the Office Action does not appear to be supported by any rationale to apply to the specific subject matter recited in claims 24, 26 and 39.

In view of the foregoing, withdrawal of the rejection of claims 24, 26 and 39 stand rejected under 35 U.S.C. §103(a) over Hill, Jr. et al. is respectfully requested.

Claims 21 and 35 stand rejected under 35 U.S.C. §103(a) over Hill, Jr. et al. in view of Rosenbaum. This rejection is moot in view of the cancellation of claims 21 and 35.

In view of the foregoing, it is respectfully submitted that this application is in condition for allowance. Favorable reconsideration and prompt allowance of claims 2, 4-9, 11-19, 24-27, 29-31, 33, 37 and 39-44 are earnestly solicited.

Should the Examiner believe that anything further would be desirable in order to place this application in even better condition for allowance, the Examiner is invited to contact the undersigned at the telephone number set forth below.

Respectfully submitted,



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